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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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7663	7590	03/08/2005	EXAMINER	
STETINA BRUNDA GARRED & BRUCKER 75 ENTERPRISE, SUITE 250 ALISO VIEJO, CA 92656			SMITH, RICHARD A	
			ART UNIT	PAPER NUMBER
			2859	

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/789,166

Applicant(s)

BRADY, JOHN R.

Examiner

R. Alexander Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 58-63 is/are allowed.
- 6) ☒ Claim(s) 1-7,30-33 and 43-50 is/are rejected.
- 7) ☒ Claim(s) 8-29,34-42 and 51-57 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20040426</u> . | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
6) <input type="checkbox"/> Other: ____ |
|--|--|

DETAILED ACTION

Claim Objections

1. Claims 14, 16, 29 and 32 are objected to because of the following informalities:

Claim 14: "the notches" in the last two lines lack antecedent basis.

Claim 16: --from-- should be inserted before "transparent material"

Claim 29: "the selected seam allowance marking" lacks antecedent basis with respect to claim 25. Furthermore, if drawn to claim 24, it still appears that "seam allowance marking" lacks an antecedent.

Claim 32: The claim should be drawn to claim --31-- and not to itself.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 5,577,328 to Kerry, Sr. in view of U.S. 1,523,919 to Vitek et al.

Kerry, Sr. discloses a transparent measuring device comprising a planar structure (14) having an upper surface and a lower surface; a plurality of markings (along 14d) formed on the upper surface of the planar structure; at least one window (18 plus the slots) extending through the planar structure; and an allowance guide (12) removably attached to the planar structure at the window; the markings include a plurality raised ribs protruding from the upper surface of the planar structure (column 4, lines 38-45) wherein the raised ribs are fabricated from transparent material; the window has a rectangular shape.

Kerry, Sr. does not disclose said raised ribs being on the lower surface.

Vitek et al. discloses a measuring device wherein the graduations are formed on the under side of the device so as to be discernible through the transparent material in order to bring the graduations in closer registry to the underlining material to improve accuracy (page 1, lines 81-91) by reducing parallax errors and discloses that the graduations are to be discernable at all times through the transparent material (page 1, lines 106+). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to relocate the ribs, taught by Kerry, Sr., to the lower surface, as taught by Vitek et al., in order to measure more accurately.

With respect to the allowance guide being a seam allowance guide: this intended use has not been given any patentable weight since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

Ex parte Masham, 2 USPQ2d 1647 (1987).

4. Claims 4, 43-45 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerry, Sr. and Vitek et al. as applied to claims 1-3 and 5 above, further in view of U.S. 3,598,493 to Fisher.

Kerry, Sr. and Vitek et al. together teach all that is claimed as discussed in the above rejections of claims 1-3 and 5 except for the raised ribs are so configured to induce visual graduation of light beams propagating therethrough, and each of said ribs having at least a proximal end and a distal end opposing to the proximal end wherein the distal ends have a surface area different from that of the proximal ends and the ribs having a triangular cross section and an inverse trapezium cross section.

Fisher discloses that a device (figure 3, 53, 54 and 60) incorporating a graduated rule having raised and lower portions (via 57) on the rule so that when light is transmitted through the rule onto the raised and lower portions, it is propagated therethrough, i.e., reflected (60), at the raised portions and each of said ribs having at least a proximal end and a distal end opposing to the proximal end wherein the distal ends have a surface area different from that of the proximal ends in order to make the rule observable to a sensor employed on the same side as the light source. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify ribs, taught by Kerry, Sr. and Vitek et al., to induce light to propagate therethrough and to use the differing surface areas, as suggested by Fisher, in order to reflect light accordingly so that the raised ribs are more observable to the observer or user.

With respect to the ribs having a triangular cross section and an inverse trapezium cross section: this limitations are only considered to be an obvious modification of a shape of the

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ribs because the courts have held that a change in shape or configuration, without any criticality, is within the level of skill in the art as the particular shape claimed by Applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide. In re Dailey, 149 USPQ 47 (CCPA 1976). In this case based on the reflection desired for observance of the ribs

5. Claims 1-3 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,193,284 to Lin in view of U.S. 5,577,328 to Kerry, Sr. and U.S. 1,523,919 to Vitek et al.

Lin discloses a transparent measuring device comprising a planar structure (1 with 8) having an upper surface and a lower surface; a plurality of markings (unmarked on both 1 and 8) formed on the upper surface of the planar structure; at least one window (the holes shown as diamonds on 1 and the slot 811 in 8) extending through the planar structure; and an allowance guide (82) removably attached to the planar structure at the window; the window has a rectangular shape; the window includes a plurality of notches formed on two opposing elongate sides of the windows.

Lin does not disclose said markings being formed on a lower surface and including a plurality of raised ribs protruding from the lower surface; wherein the raised ribs are fabricated from transparent material; and the notches being 1/8 inches long.

Kerry, Sr. discloses a transparent measuring device comprising a planar structure (14) having an upper surface and a lower surface; a plurality of markings (along 14d) formed on the upper surface of the planar structure; at least one window (18 plus the slots) extending through the planar structure; and an allowance guide (12) removably attached to the planar structure at

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the window; the markings include a plurality raised ribs protruding from the upper surface of the planar structure (column 4, lines 38-45) wherein the raised ribs are fabricated from transparent material. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the markings, taught by Lin, to be a plurality of raised ribs and to fabricate them from transparent material, as taught by Kerry, Sr., in order to make the markings more noticeable and less likely to be worn off and in order to allow the device and markings to be integrally formed.

Vitek et al. discloses a measuring device wherein the graduations are formed on the under side of the device so as to be discernible through the transparent material in order to bring the graduations in closer registry to the underlining material to improve accuracy (page 1, lines 81-91) by reducing parallax errors and discloses that the graduations are to be discernable at all times through the transparent material (page 1, lines 106+). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to relocate the ribs, taught by Lin and Kerry, Sr., to the lower surface, as taught by Vitek et al., in order to measure more accurately.

With respect to the notches being 1/8 inches long : this limitation is only considered to be the "optimum" values of the size of the notches of the device disclosed by Lin, as stated above, that a person having ordinary skill in the art would have been able to determine using routine experimentation based, among other things, on the provided a scale locking feature at intervals commonly used on measuring rules when measuring. See In re Boesch, 205 USPQ 215 (CCPA 1980).

With respect to the allowance guide being a seam allowance guide: this intended use has not been given any patentable weight since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

Ex parte Masham, 2 USPQ2d 1647 (1987)

6. Claims 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerry, Sr. and Vitek et al. as applied to claims 1-3 and 5 above, further in view of U.S. 3,738,010 to Carder.

Kerry, Sr. and Vitek et al. together teach all that is claimed as discussed in the above rejections of claims 1-3 and 5 except for the planar structure further comprises a plurality of circular grooves recessed from the lower surface thereof, a plurality of elastomeric O-rings partially embedded in the circular grooves; each of the O-rings has a cross-sectional diameter equal to or greater than the height of the grooves.

Carder discloses a straight edge employing a planar structure having a plurality of circular grooves recessed from the lower surface thereof, and discloses inserts of rubber, hook and loop fasteners, and a rigid ring wherein the rubber or fasteners are selectively chosen in order to hold the straightedge on a surface. Carder discloses that the height of the insert exceeds that of the groove. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device, taught by Kerry, Sr. and Vitek et al., to include a groove and an insert of a height equal to or greater than the height of the groove, as suggested by Carder, in order to prevent the straight edge from sliding on a surface.

With respect to the inserts being a plurality of elastomeric O-rings: this limitation is only considered to be the use of "optimum" or "preferred" materials that a person having ordinary skill in the art at the time the invention was made using routine experimentation would have found obvious to provide to make inserts, as suggested by Carder, since they are well known types of materials used to connect components and since it has been held to be a matter of obvious design choice and within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use of the invention. In re Leshen, 125 USPQ 416. In this case, in order to provide a commercially available elastomeric device cheaply that does not require assembly, that will fit in the groove, and will prevent the device from sliding, as already suggested by Carder.

7. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kerry, Sr. and Vitek et al. as applied to claims 1-3 and 5 above, further in view of U.S. 4,821,424 to Loggins.

Kerry, Sr. and Vitek et al. together teach all that is claimed as discussed in the above rejections of claims 1-3 and 5 except for at least one handle inserted through one of the windows.

Loggins discloses a device and teaches that a handle may be added through a window in order to facilitate control and movement during use (column 2, lines 57-61). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device, taught by Kerry, Sr. and Vitek et al., to include a window with a handle inserted through, as suggested by Loggins, in order to help facilitate control and movement of the device.

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8. Claims 43-45, 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin, Kerry, Sr. and Vitek et al. as applied to claims 1-3 and 5-7 above, further in view of U.S. 3,598,493 to Fisher.

Lin, Kerry, Sr. and Vitek et al. together teach all that is claimed as discussed in the above rejections of claims 1-3 and 5-7 except for each of said ribs having at least a proximal end and a distal end opposing to the proximal end wherein the distal ends have a surface area different from that of the proximal ends and the ribs having a triangular cross section and an inverse trapezium cross section.

Fisher discloses that a device (figure 3, 53, 54 and 60) incorporating a graduated rule having raised and lower portions (via 57) on the rule so that when light is transmitted through the rule onto the raised and lower portions, it is propagated therethrough, i.e., reflected (60), at the raised portions and each of said ribs having at least a proximal end and a distal end opposing to the proximal end wherein the distal ends have a surface area different from that of the proximal ends in order to make the rule observable to a sensor employed on the same side as the light source. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify ribs, taught by Lin, Kerry, Sr. and Vitek et al., to induce light to propagate therethrough and to use the differing surface areas, as suggested by Fisher, in order to reflect light accordingly so that the raised ribs are more observable to the observer or user.

With respect to the ribs having a triangular cross section and an inverse trapezium cross section: this limitations are only considered to be an obvious modification of a shape of the ribs because the courts have held that a change in shape or configuration, without any criticality, is within the level of skill in the art as the particular shape claimed by Applicant is nothing more

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than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide. In re Dailey, 149 USPQ 47 (CCPA 1976). In this case based on the reflection desired for observance of the ribs.

9. Claims 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerry, Sr., Vitek et al. and Fisher as applied to claims 4, 43-45 and 48 above, further in view of U.S. 3,738,010 to Carder.

Kerry, Sr., Vitek et al. and Fisher together teach all that is claimed as discussed in the above rejections of claims 4, 43-45 and 48 except for the the planar structure further comprises a plurality of circular grooves formed on the lower surface, and a plurality of elastomeric O-rings partially embedded in the circular grooves.

Carder discloses a straight edge employing a planar structure having a plurality of circular grooves recessed from the lower surface thereof, and discloses inserts of rubber, hook and loop fasteners, and a rigid ring wherein the rubber or fasteners are selectively chosen in order to hold the straightedge on a surface. Carder discloses that the height of the insert exceeds that of the groove. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device, taught by Kerry, Sr., Vitek et al. and Fisher, to include a groove and an insert of a height equal to or greater than the height of the groove, as suggested by Carder, in order to prevent the straight edge from sliding on a surface.

With respect to the inserts being a plurality of elastomeric O-rings: this limitation is only considered to be the use of "optimum" or "preferred" materials that a person having ordinary skill in the art at the time the invention was made using routine experimentation would have

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found obvious to provide to make inserts, as suggested by Carder, since they are well known types of materials used to connect components and since it has been held to be a matter of obvious design choice and within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use of the invention. In re Leshen, 125 USPQ 416. In this case, in order to provide a commercially available elastomeric device cheaply that does not require assembly, that will fit in the groove, and will prevent the device from sliding, as already suggested by Carder.

10. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kerry, Sr., Vitek et al. and Fisher as applied to claims 4, 43-45 and 48 above, further in view of U.S. 4,821,424 to Loggins.

Kerry, Sr., Vitek et al. and Fisher together teach all that is claimed as discussed in the above rejections of claims 4, 43-45 and 48 except for at least one handle inserted through one of the windows.

Loggins discloses a device and teaches that a handle may be added through a window in order to facilitate control and movement during use (column 2, lines 57-61). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device, taught by Kerry, Sr., Vitek et al. and Fisher, to include a window with a handle inserted through, as suggested by Loggins, in order to help facilitate control and movement of the device.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 43-45, 48 and 49 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3 and 8 of U.S. Patent No. 6,799,379. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following:

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With respect to claims 43, 48 and 49: Claim 43 herein discloses that the raised rib has a distal end having a surface area different from that of the proximal end and a plurality of windows. Claim 48 and 49, respectively, claim the windows as rectangular and having two edges with a plurality of notches. Claim 3/1 of '379 discloses that at least one window is in the device and that the raised rib has a square shoulder stepped cross-sectional configuration. Based on claim 3 and figures 1 and 5 of '379, it would have been obvious to one of ordinary skill in the art at the time of the invention to add the plurality of rectangular windows, the notches to the elongate edges and the raised rib having a surface area of the distal end to be different from that of the proximal end, taught by '379, since '379 discloses a different surface area in order to reflect incident light, plural rectangular windows in order to allow more unobstructed viewing of the fabric beneath the window, and notches along the edges of the windows for placement of an alignment device.

With respect to claims 44 and 45 respectively wherein the raised have triangular or inverse trapezium cross-section: '379 discloses that square shoulder stepped or a beveled sidewall configuration can be used in the alternative. The triangular and inverse trapezium as claimed are considered to be an obvious modification of the beveled sidewall configuration since it would have been obvious to one of ordinary skill in the art that a beveled sidewall configuration can have either a triangular or a inverse trapezium cross-section and since '379 already discloses a beveled sidewall in the inverse trapezium cross-section and discloses that the raised rib can have alternative configurations.

Allowable Subject Matter

13. Claims 58-63 are allowable.
14. Claims 8-13, 15, 17-28, 34-42 and 51-57 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims.
15. Claims 14, 16 and 29 would be allowable if rewritten to overcome the claim objections set forth in this Office Action and to include all of the limitations of the base claim and any intervening claims.
16. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The prior art cited in PTO-892 and not mentioned above disclose related devices.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. Alexander Smith whose telephone number is 571-272-2251. The examiner can normally be reached on Monday through Friday from 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F. Gutierrez can be reached on 571-272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'R. Alexander Smith', with a long horizontal flourish extending to the right.

R. Alexander Smith
Patent Examiner
Technology Center 2800

RAS
March 7, 2005